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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,421	03/23/2004	Hideaki Naruse	Q80646	2271
23373	7590	02/27/2007	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			THOMPSON, CAMIE S	
			ART UNIT	PAPER NUMBER
			1774	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/27/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/806,421	NARUSE ET AL.	
	Examiner Camie S. Thompson	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on Amendment filed November 15, 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 11/15/2006.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicant's amendment and accompanying remarks filed November 15, 2006 are acknowledged.
2. Examiner acknowledges amended claims 1-2 and 6.
3. Examiner acknowledges cancelled claim 5.
4. The rejection of claims 1-4 under 35 U.S.C. 102(b) as being anticipated by Kotani et al., U.S. Patent Number 5,766,751 is overcome by applicant's amendment.
5. The rejection of claims 1-20 under 35 U.S.C. 102(e) as being anticipated by Iwanaga, U.S. Pre Grant Publication 2004/0209090 is overcome by applicant's submission of the terminal disclaimer.
6. The rejection of claims 1-20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Application 10/759,139 is overcome by applicant's submission of the terminal disclaimer.

#### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-2, 4, 8-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Sawai et al., U.S. Patent Number 6,638,645.

Sawai discloses a film for use in an organic EL device. The reference discloses a laminated film that comprises a substrate (base film) made from PET and a gas barrier layer made from organic inorganic hybrid materials (see column 2, lines 45-62). Figure 2 of the reference shows that the gas barrier layer is between two base material films. Also, Sawai discloses that the organic inorganic hybrid material lay has a thickness of 1 micron and that the substrate (base) layer has a thickness of 12 microns. Tables 1 and 2 of the reference disclose the oxygen permeability of the organic inorganic hybrid layer that corresponds to the required oxygen permeability for the gas barrier layer of the present claims. The Sawai reference does not disclose that the gas barrier layer is formed by the sol-gel method. Claim 1 is a product-by-process claim. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP 2113. Both the reference and the present claims comprises a film for a display device wherein the film comprises a base material film and at least one gas barrier layer wherein the gas barrier layer is an organic inorganic hybrid layer. The manner in which the gas barrier layer is formed does not make it a different product from the recited claims.

9. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Ishikawa, U.S. Pre Grant Publication 2004/0058157.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Ishikawa discloses a gas barrier film having an organic-inorganic hybrid coating layer formed by the sol-gel method on a transparent base film having a glass transition temperature of 100 deg C or higher (see paragraph 0008 and paragraphs 0022-0026). Paragraph 0045 of the reference discloses that the thickness of the base film is preferably 5-500 microns. Paragraphs 0031-0032 disclose that the base film can be a layered compound. Paragraph 0055 of the Ishikawa reference discloses that the polymers have a hydrogen bond-forming group such as a hydroxyl group as required by the present claims. Table 1 discloses the gas transmission rates of the gas barrier films. The examples in the reference discloses a method for producing a gas barrier laminate film wherein a solution containing a metal alkoxide such as an alkoxy silane and a polymer having a hydroxyl group on a base material film and the solution irradiated with an electromagnetic wave such as a microwave (see paragraph 0048-0049 and 0106).

*Response to Arguments*

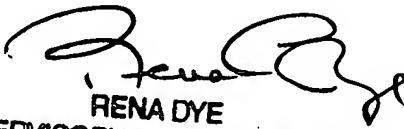
10. Applicant's arguments with respect to instant claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Camie S. Thompson whose telephone number is (571) 272-1530. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 pm. If

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attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L Dye, can be reached at (571) 272-3186. The fax phone number for the Group is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
RENA DYE  
SUPERVISORY PATENT EXAMINER

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